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No. 96-1312

In the
Supreme Court of the United States
OCTOBER TERM, 1996

ROBERT W. KEARNS,
Petitioner,
v.
GENERAL MOTORS CORPORATION
AND BROWN'S BUICK AND ISUZU,
Respondents.

ON PETITION FOR WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT.

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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BATEMAN & SLADE, INC. BOSTON, MASSACHUSETTS

STATEMENT PURSUANT TO SUPREME COURT RULE 29.1

General Motors Corporation does not have a parent company. Its wholly-owned subsidiaries that have issued shares to the public are identified below:

Publicly Traded Subsidiaries, Joint Ventures and Affiliates:

American Mobile Satellite Corporation
Detroit Diesel Corporation
Fiem Sung Sun (India) Ltd.
Isuzu Motors Limited
Nippan Avionics Co. Ltd.
Suzuki Motor Corp.

Other Subsidiaries, Joint Ventures and Affiliates:

AC Battery Corporation
AC Rochester Luxembourg S.A.
AMBRAKE Corporation
Adam Opel Aktiengesellschaft
Adela Investment Company S.A.
AeroVironment, Inc.
Alambrados y Circuitos Electricos, S.A. de C.V.
Allison Transmission Europe B.V.
Alpha Trans Leasing Verwaltungsgeselischaft mbH
Applied Ceramics
Arabian Battery Holding Company
Arabian Financing Company
Arcomex S.A. de C.V.
Argonaut Holdings, Inc.
Argonaut Relocation Services, L.L.C.
Ameses Electricos Automotrices S.A. de C.V.

Other Subsidiaries, Joint Ventures and Affiliates (Cont'd):

Asset Leasing GmbH
Aura S.r.I.
Autocable Industries (Pty) Limited
Autohaus am Nordring GmbH, Berlin
Auto Lease Payment Corporation
Automotive Battery Manufacturing, Inc.
Autos y Maquinas del Ecuador S.A. (AYMESA)
Avis Europe Ltd
Avis, Inc.
Banco General Motors S.A.
Battery Technology Services, Inc.
Beijing Wanyuan GM Automotive Electronic Control Co., Ltd. (aka Beijing WY-GM Automotive Electronic Control Co., Limited)
Brazauto Industria er Comercio Ltda.
Brazauto Trading (Cayman) Limited
Bujias Mexicanas, S.A. de C.V.
CAMI Automotive, Inc.
Calsonic Harrison Co., Ltd.
Carus Grundstucks-Vermietungsgesellschaft mbH & Co., Object Kuno 65 KG
Carus Grundstucks-Vermietungsgesellschaft mbH & Co., Object Leo 40 KG
Centro Tecnico Herramental, S.A. de C.V.
Chevrolet Sociedad Anonima de Ahorro para Fines Determinados
Cilva Holdings Plc.
Cimflex Teknowledge
Coalition Undertaking Remedial Efforts, Inc.
Compagnie de Faisceaux Tunisiens International S.A.
Componentes Delfa, C.A.
Componentes Para Automotores, S.A. de C.V.

Other Subsidiaries, Joint Ventures and Affiliates (Cont'd):

Condupac International, Inc.
Consorcio Nacional GM Ltda.
Controladora General Motors, S.A. de C.V.
Controladora Mexicana de Autopartes, S.A. de C.V.
Cordaflex, S.A. de C.V.
DHB America Inc.
DHB Componentes Automotivos S.A.
DRB s.a./n.v. (aka Delco Remy Belgique)
Daewood Automotive Components, Ltd.
Dealership Liquidations, Inc.
Delco Remy-Componentes Electronicos, LDA.
(aka Delco Remy (Portugal) Componentes Electricos, Lda.)
Delkor Corporation (aka Chusikhoesa Delkor)
Delmex de Juarez, S.A. de C.V.
Delphi Alambrados Automotrices, S.A. de C.V.
Delphi Asientos, S.A.
Delphi Automotive Systems Australia Ltd.
Delphi Automotive Systems do Brasil Ltda.
Delphi Automotive Systems China, Inc.
Delphi Automotive Systems Deutschland GmbH
Delphi Automotive Systems Espana, S.A.
Delphi Automotive Systems, Inc.
Delphi Automotive Systems Luxembourg S.A.
Delphi Automotive Systems Poland Sp. z o.o.
Delphi Automotive Systems Private Limited
Delphi Automotive Systems, S.A. de C.V.
Delphi Automotive Systems Singapore Pte Ltd
Delphi Automotive Systems Vienna GmbH
Delphi Cableados, S.A. de C.V.
Delphi Calsonic Compressors, S.A.
Delphi Cetasa, S.L.
Delphi Chassis Systems UK Limited

Other Subsidiaries, Joint Ventures and Affiliates (Cont'd):

Delphi Cisa, S.A.
Delphi Colvegasa, S.A.
Delphi Componentes Mecanicos de Matamoros, S.A. de C.V.
Delphi Componentes, S.A.
Delphi Energy and Engine Management Systems (M) Sdn Bhd
Delphi Energy and Engine Management Systems UK Overseas Corporation
Delphi Ensamble de Cables y Componentes, S.A. de C.V.
Delphi Ensamble De Cubiertas Automotrices, S.A. de C.V.
Delphi France Automotive Systems S.A.
Delphi Harrison Calsonic S.A.
Delphi Interior Systems South Africa (Pty)
Delphi Italia Automotive Systems S.r.l.
Delphi Italia Service Center S.r.l.
Delphi L'EM Argentina S.A.
Delphi Overseas Corporation
Delphi Packard Austria Ges.mbH
Delphi Packard Deutschland GmbH
Delphi Packard Electric (Guangzhou) Company, Ltd.
Delphi Packard Electric Sielin Argentina S.A.
Delphi Packard Electric Systems (M) Sdn Bhd
Delphi Packard Electric Venezuela C.A.
Delphi Packard Elektrik Sistemleri Limited Sirketi
Delphi Packard Romania s.r.l.
Delphi Packard Sistemas Electricos, S.A.
Delphi Rimir, S.A. de C.V.
Delphi Saginaw Steering Systems UK Limited
Delphi Steering (Malaysia) Sdn Bhd
Delphi Teknik Oto Yan Sanayi Limited Sirketi
Delphi Unicables, S.A.
Delphi Vestiduras Fronterizes, S.A. de C.V.
Delredo, S.A. de C.V.

Other Subsidiaries, Joint Ventures and Affiliates (Cont'd):

Detroit Diesel Corporation
Diavia Aire, S.A.
Diavia Brasil-Ar Condicionado Ltda.
DR DE CHIHUAHUA, S.A. de C.V.
EDESA Societe Anonyme Holding
EL-MO Leasing Corporation
EMD Leasing Corporation
ENCI S.A.R.L.
EPEC S.A.
Electro-Motive Maintenance Operations Pty Ltd
Empresas "Ca-Le" de Tlaxcala S.A. de C.V.
Exhaust Systems Corporation
f & g megamos Sicherheitselektronik GmbH
Fabrica Nacional De Autobuses, C.A.
Fiem Sang Sun (India) Ltd.
Fisher Body Limited
Freevale Limited
GM Allison Japan Limited
GM Auto Receivables Co.
GM-DI Leasing Corporation
GM Europe GmbH (aka GM Europe GmbH Russelsheim)
GM Factoring Sociedade de Fomento Comercial Ltda.
G.M. Holding (Portugal) SGPS, Lda.
GM Investment Trustees Limited
GM Leasing S.A.-Arrendamento Mercantil
GM Mergeco Corp.
GM Nigeria Limited
GM Ovonic L.L.C.
GM Personnel Services, Inc.
GM-Saab Communication GmbH
GM (UK) Pension Trustees Limited
GMC Truck Motors Development Corporation

Other Subsidiaries, Joint Ventures and Affiliates (Cont'd):

GMLG Ltd.
GMOC Administrative Services Corporation
GMOC Australia Pty. Ltd.
GMODC Finance N.V.
Genasys L.C.
General International Insurance Services Limited
General International Limited
General International (UK) Limited
General Motors Acceptance Corporation
General Motors de Argentina S.A.
General Motors Asia, Inc.
General Motors Asian and Pacific Operations (Pte) Ltd.
General Motors Automobiles Philippines, Inc.
General Motors do Brasil Ltda.
General Motors of Canada Limited-General Motors du Canada Limitee
General Motors Cancer Research Foundation, Inc.
General Motors Chile S.A., Industria Automotriz
General Motors China (Components), Inc.
General Motors China, Inc.
General Motors Colmotores, S.A.
General Motors Commercial Corporation
General Motors Coordination Center N.V.
General Motors del Ecuador S.A.
General Motors Egypt, S.A.E.
General Motors (Europe) AG (aka General Motors Europe)
General Motors Export Corporation
General Motors Foreign Sales Corporation
General Motors Foundation, Inc.
General Motors GmbH & Co. OHG
General Motors Hellas, A.B.E.E.
General Motors-Holden's Automotive Limited

Other Subsidiaries, Joint Ventures and Affiliates (Cont'd):

General Motors-Holden's Sales Pty. Limited
General Motors Holding Espana, S.A.
General Motors Holdings (U.K.)
General Motors Import & Distribution GmbH
General Motors Importaktiebolag (aka General Motors Import AB)
General Motors India Limited
General Motors Indonesia, Inc.
General Motors Interamerica Corporation
General Motors International Operations, Inc.
General Motors Investment Management Corporation
General Motors Investment Services Company N.V.
General Motors Japan Ltd. (trade name: Nihon General Motors Kabushiki Kaisha)
General Motors Kenya Limited
General Motors Korea, Inc.
General Motors Locomotive Group India Limited
General Motors Market Development of Canada Limited (aka Compagnie De Developpement Du Marche and General Motors Du Canada Limitee)
General Motors de Mexico, S.A. de C.V.
General Motors Nederland B.V.
General Motors New Zealand Pensions Limited
General Motors Nordiska AB
General Motors Overseas Commercial Vehicle Corporation
General Motors Overseas Corporation
General Motors Overseas Distribution Corporation
General Motors Peru S.A.
General Motors Poland Spolka, zo. o.
General Motors Receivables Corporation
General Motors Research Corporation
General Motors Taiwan Ltd.

Other Subsidiaries, Joint Ventures and Affiliates (Cont'd):

General Motors (Thailand) Ltd.
General Motors Uruguay, S.A.
General Motors U.S. Trading Corp.
General Motors Venezolana, C.A.
General Motors Women's Foundation
General Motors Yugoslavia, trade company with limited liability
(aka General Motors Yugoslavia d.o.o.)
Genie Mecanique Zairois, S.A. R. L.
Grand Pointe Holdings, Inc.
Group Lotus, plc
Holden New Zealand Limited
Holden's Agencies Pty. Limited
Holden's Motor Overseas Corporation Limited
Hubei Delphi Automotive Generator Co., Ltd.
Hughes Electronics Corporation
I. K. Coach Co., Ltd.
IBC Vehicles (Distribution) Limited
IBC Vehicles Limited
INLAN-Industria de Componentes Mecanicos, S.A.
ITT Automotive Electrical Systems, Inc.
Industries Mecaniques Maghrebines, S.A.
Industrija Delova Automobila, Kikinda
Isuzu Credit Service Co., Ltd.
Isuzu-General Motors Australia Limited
Isuzu Motors Limited
Japan Auto Service Co., Ltd.
Jennings Motors, Inc.
Jinbei GM Automotive Co. Ltd.
KDS Company, Ltd.
Katcon, S.A. de C.V.
Lidlington Engineering Company, Ltd.
Lutton Design Centre Limited

Other Subsidiaries, Joint Ventures and Affiliates (Cont'd):

MB Cable Confection Sdn. Bhd. (Malaysia)
MLS UK Ltd.
MLS USA, Inc.
Macopel, S.A. de C.V.
Mechanical Breakdown Insurance Management Limited
Metal Casting Technology, Inc.
Middle East Battery Company
Millbrook Land and Co., Ltd.
Millbrook Pension Management Ltd.
Millbrook Proving Ground, Ltd.
Motor Enterprises, Inc.
Motors Trading Corporation
New-Cen Commercial Corporation
New Cure, Inc.
New United Motor Manufacturing, Inc.
New Venture Gear, Inc.
North American New Cars, Inc.
Omnibus BB Transportes, S.A.
Opel Austria GmbH
Opel-Automobilwerk Eisenach-PKW GmbH
(aka Opel-AWE GmbH)
Opel Belgium N.V.
Opel C&S spol.s.r.o.
Opel China GmbH
Opel Eisenach GmbH
Opel Espana de Automoviles, S.A.
Opel France S.A.
Opel Guangzhou Precision Machining Co. Ltd.
Opel Hungary Automobile Production Ltd.
Opel Hungary Automotive Distribution Ltd.
Opel Hungary Automotive Manufacturing Ltd.
Opel Ireland Limited

Other Subsidiaries, Joint Ventures and Affiliates (Cont'd):

Opel Italia S.p.A.
Opel Nederland B.V.
Opel Norge
Opel Oy
Opel Portugal-Comercio e Industria de Veiculos S.A.
Opel Polska sp. zoo
Opel (Suisse) SA
Opel Turkiye Limited Sirketi (aka Opel Turkey)
Opel-Wohnbau GmbH
P.T. Mesin Isuzu Indonesia
P.T. Packard Kabelindo Murni Indonesia
PDES, Inc.
PES/SCC
PT General Motors Buana Indonesia
Packard CTA Pty. Ltd.
Packard Electric Bai Cheng Co., Limited
Packard Electric Ceska republike s.r.o.
Packard Electric Hebi
Packard Electric Ireland Limited
Packard Electric Shanghai Co., Limited
Packard Electric Vas kft
Packard Hughes Interconnect Company
Packard Hughes Interconnect Connection System
Packard Hughes Interconnect Engineering Services
Packard Hughes Interconnect Mexico
Packard Hughes Interconnect Wiring Systems
Productos Delco de Chihuahua, S.A. de C.V.
Promotora de Partes Electricas Automotrices S.A. de C.V.
Provencorp S.A.
Qual-Effic Services, Inc.
Radiadores Richard, S.A.
Reinshagen GmbH

Other Subsidiaries, Joint Ventures and Affiliates (Cont'd):

Reinshagen Tournai S.A.
Rio Bravo Electricos, S.A. de C.V.
Riverfront Development Corporation
Riverfront Holdings, Inc
Robotic Vision Systems, Inc.
Ruedas de Aluminio, C.A.
Saab Automobile AB
Saab Cars Holdings, Inc.
Saab Cars USA, Inc.
Saab Financial Services Corp.
Saab Opel Sverige AB
Saginaw Deutschland GmbH
Saginaw Norinco Lingyun Drive Shaft Co., Ltd.
Saturn Corporation
Saturn County Bond Corporation
Saturn Distribution Corporation
Shanghai Delco International Battery Company, Ltd.
Shinsung Packard Company, Ltd.
Sistemas de Asientos Para Vehiculos Automotrices
Sistemas Electricos y Conmutadores, S.A. de C.V.
Sistemas Para Automotores de Mexico, S.A. de C.V.
Sociedad de Comercializacion Internacional Colmotores, S.A.
Societe Francaise des Amortisseurs de Carbon S.A. (aka Delco de Carbon)
Subaru-Isuzu Automotive, Inc.
Sung San Company, Ltd
Suzuki Motor Corporation
Texton P.L.C.
Texton S.A.
Trinter Sociedad Anonima Comercial, Industrial y Financera
Truck and Bus Engineering U.K., Limited
U.M.I. Universal Motors Israel Ltd.

Other Subsidiaries, Joint Ventures and Affiliates (Cont'd):

United Australian Automotive Industries Limited
Unterstuetzungsgesellschaft der Kabelwerke Reinshagen GmbH (aka Unterstutzungsgesellkschaft mbH)
Uptown Land Development Corporation
Uveral S.A.
VHC Sub-Holdings (UK) Ltd
Vauxhall Motors (Finance) Plc
Vauxhall Motors Limited
Vauxhall Properties Limited
View Engineering, Inc.
Volvo GM Canada Heavy Truck Corporation
Volvo GMK Heavy Truck Corporation
WRE, Inc.
Woodbridge Foam Deutschland, GMBH
Zhejiang Delphi Asia-Pacific Brake Co. Ltd.

Partnerships:

ASEC Manufacturing
ASEC Sales
GM-ARA Industrial Cleaning
Low Emission Paint Research and Development Partnership
Low Emissions Technologies Research and Development Partnership
Supercomputer Automotive Applications Partnership
United States Automotive Materials Partnership

Consortia:

Auto/Oil Quality Improvement Research Program
Automotive Polymer-Based Companies Joint Venture and Development Partnership (aka Automotive Composites Consortium)

Consortia (Cont'd):

CAD/CAM Consortium
Electrical Wiring Component Applications Partnership
Environmental Research Consortium
High Speed Serial Data Communications Research and Development Consortium
Low Emissions Technologies Research and Development Partnership
National Automated Highway Systems Consortium
Occupant Safety Research Partnership
U.S. Council for Automotive Research
United States Advanced Battery Consortium
Vehicle Recycling Consortium

Other Subsidiaries, Joint Ventures and Affiliates of Hughes Electronics Corporation:

ACCSCO S.A.
ACHIP Technologies, Inc.
AMI Instruments, Inc.
ARINC Incorporated
Advanced Toll Management Corp.
American Mobile Satellite Corporation
Anadolu Otomotiv Sanayi VE Ticaret A.S.
Applied Intelligent Systems, Inc.
Aralmex, S.A. de C.V.
Avicom International, S.A.
CEI Co., Ltd.
California Broadcast Center, LLC
Circuitos Binancionales de Tijuana S.A. de C.V.
DTVI One, Inc.
DTVI Two, Inc.
Delco Electronics Asia/Pacific Pte Ltd.

Other Subsidiaries, Joint Ventures and Affiliates of Hughes Electronics Corporation (cont'd):

Delco Electronics Corporation
Delco Electronics Europe GmbH
Delco Electronics Overseas Corporation
Delco Electronics Singapore Pte. Ltd.
Delco Electronics (Suzhou) Co., Ltd.
Delnosa, S.A. de C.V.
Deltronicos de Matamoros, S.A. de C.V.
DIRECTV Enterprises, Inc.
DIRECTV Global, Inc.
DIRECTV, Inc.
DIRECTV International, Inc.
DIRECTV Japan Kabushiki Kaisha
DIRECTV Merchandising, Inc.
DIRECTV Operations, Inc.
Empressa Nacional de Optica SA
Ensambladores Electronicos de Mexico, S.A.
FLIR Systems, Inc.
FUBA Automotive GmbH
FUBA Automotive LLC
First Portland Technology Corp.
Groom Aviation Limited
Puiado y Control SA
H E Microwave Corporation
HBH Company
HE Holdings, Inc. (dba Hughes Electronics)
HNS-Clairtel GP, Inc.
HNS Common Carrier Services, Inc.
HNS India, Inc.
HNS-India VSAT, Inc.
HNS-Italia S.r.L.
HNS de Mexico, S.A. de C.V.

Other Subsidiaries, Joint Ventures and Affiliates of Hughes Electronics Corporation (cont'd):

HNS-Shanghai, Inc.
HNS Shared Hub Services, Inc.
Hughes Aircraft of Canada Limited
Hughes Aircraft Company
Hughes Aircraft Holdings Canada Ltd.
Hughes Aircraft Mississippi, Inc.
Hughes Aircraft-South Carolina
Hughes Aircraft Systems International
Hughes Airport Development Corporation Sdn Bhd
Hughes Arabia Limited
Hughes Asia Pacific Hong Kong Limited
Hughes Australia International PTY Ltd.
Hughes-Avicom International, Inc.
Hughes do Brasil Eletronica e Comunicacoes S.A.
Hughes Communications Carrier Services, Inc.
Hughes Communications Galaxy, Inc.
Hughes Communications GLA, Inc.
Hughes Communications, Inc.
Hughes Communications Japan, Inc.
Hughes Communications Satellite Services, Inc.
Hughes Communications Services, Inc.
Hughes Danbury Optical Systems, Inc.
Hughes Data Systems
Hughes Electronics Reality, Inc.
Hughes Electronic Systems (Malaysia) Sdn Bhd
Hughes Electronic Technologies, Inc.
Hughes Electronics Holding GmbH
Hughes Electronics International, Inc.
Hughes Electronics Manufacturing Service Company
Hughes Environmental Systems, Inc.
Hughes Escorts Communications Limited

Other Subsidiaries, Joint Ventures and Affiliates of Hughes Electronics Corporation (cont'd):

Hughes Espana S.A.
Hughes ESSM Co.
Hughes Europe N.V.
Hughes Flight Training Limited
Hughes Foreign Sales Corporation
Hughes Georgia, Inc.
Hughes Information Systems Company
Hughes International Corporation
Hughes International GmbH
Hughes International de Mexico, S.A. de C.V.
Hughes International Sales Corporation
Hughes International Sales Corporation No. 2
Hughes Investment Management Company
Hughes Ispat Limited
Hughes-Kenwood RDSS, Inc.
Hughes Lexington, Inc.
Hughes Microelectronics Europa Espana, S.A.
Hughes Microelectronics Europe Limited
Hughes Microelectronics Limited
Hughes Middle East Limited
Hughes Missile Systems Company
Hughes Nadge Corporation
Hughes Network Systems France
Hughes Network Systems, Inc.
Hughes Network Systems International Service Company
Hughes Network Systems Limited
Hughes Olivetti Telecom, Ltd.
Hughes Olivetti Telecom, N.V.
Hughes Power Products, Inc.
Hughes Research Analytics, Inc.
Hughes Research Laboratories, Inc.

Other Subsidiaries, Joint Ventures and Affiliates of Hughes Electronics Corporation (cont'd):

Hughes Simulation International, Inc.
Hughes Software Systems Private Limited
Hughes Space and Communications Company
Hughes Space and Communications International, Inc.
Hughes STX Corporation
Hughes Systems Management International
Hughes Technical Services Company
Hughes Telecommunications & Space Company
Hughes Training, Inc.
Hughes Training Systems, Inc.
Hughes Transportation Control Systems, Inc.
Hughes (U.K.) Limited
ICO Global Communications (Holdings) Limited
i-Logix Inc.
International Electro-Optical Industry Anonim Sirketi
International Electronics Systems, Inc.
Japan Satellite Communications Network Corporation
L-T Ranches, Inc.
MDP, Ltd.
MESC Holdings, Inc.
MESC Overseas, Ltd.
Magnavox Systems, Limited
Mecel AB
Microelectronics and Computer Technology Corporation
NETSAT Express, Inc.
Nippon Avionics Co., Ltd.
PT. Pasifik Satelit Nusantara
Satelitron S.A. de C.V.
Serampang Hughes Sdn. Bhd.
Shanghai Delco Electronics and Instrumentation Co., Ltd.
Shanghai Hughes Network Systems

Other Subsidiaries, Joint Ventures and Affiliates of Hughes Electronics Corporation (cont'd):

Spectrolab, Inc.
Standard Missile Company, L.L.C.
Systems Building Corp.
The Gulf Industrial Technology Company (KSC)
Translant, Inc.
UKADGE Systems Limited
XMC Holdings, Ltd.

Partnerships:

AMRAAM International Licensing Company
ERAPSCO
G. & F. Company
Galaxy Latin America
H & D Radio Frequency Identification Products
H & R Company
HKV
HMK
Harris-Magnavox Systems Corporation
Hughes-Pareto Research Partnership
IRISS Company
Lifestar Digital Television, Inc.
RALS (aka RAM Alternate Launcher System)
SJ & LA Associates
Verinet

Other Subsidiaries, Joint Ventures and Affiliates of General Motors Acceptance Corporation:

ABA Motriz Financiamiento S.A. de C.V.
Banque Opel

Other Subsidiaries, Joint Ventures and Affiliates of General Motors Acceptance Corporation (cont'd):

CIM Insurance Corporation
Cadmic Agency Corporation
Cadmic Agency Corporation of Ohio
Canadian Securitized Auto Receivables Corporation
Capital Auto Receivables, Inc.
Car Care Plan GmbH
Car Care Plan (Holdings) Limited
Car Care Plan Limited
Car Care Plan (Securities Division) Limited
Commercial Care Plan Limited
Empresa Mixta GEMACVEN, S.A.
Executive Closing Services, Inc.
Executive Trustee Services, Inc.
GM Credit AB
GM Finance HB
GM Motor Club, Inc.
GMAC de Argentina S.A.
GMAC Arrendadora S.A. de C.V.
GMAC, Australia (Finance) Limited
GMAC Automotriz Limitada
G.M.A.C. Colombia S.A.
GMAC Comercial Automotriz Chile S.A. (aka GMAC Chile)
G.M.A.C.-Comercio e Aluguer de Veiculos, Lda.
GMAC Commercial Corporation
GMAC Commercial Equity Investments, Inc.
GMAC Commercial Mortgage Corporation
GMAC Commercial Mortgage Securities, Inc.
GMAC Commercial Realty, Inc.
GMAC del Ecuador S.A.
GMAC Espana, S.A. de Financiacion
GMAC Espana, S.A. Sociedad de Arrendamiento Financiero

Other Subsidiaries, Joint Ventures and Affiliates of General Motors Acceptance Corporation (cont'd):

G.M.A.C. Financierse Colombia S.A. Compania de Financiamiento Comercial
GMAC Finansiering A/S
GMAC Holding S.A. de C.V.
GMAC International Finance, B.V.
GMAC Italia Leasing S.p.A.
GMAC Leaseco Limited/GMAC Location Limitee
GMAC Leasing Corporation
GMAC Leasing (U.K.) Limited
GMAC Leasing (U.K.) (No. 1) Limited
GMAC Leasing (U.K.) (No. 2) Limited
GMAC Leasing (U.K.) (No. 3) Limited
GMAC Mortgage Corporation
GMAC Mortgage Corporation of TN
GMAC Mortgage Group, Inc.
GMAC Mortgage Holdings, Inc.
GMAC Mortgage Securities, Inc.
GMAC Mortgage Securities II, Inc.
GMAC RF, Inc.
GMAC Rahoitus Oy
GMAC Sverige AB
General Acceptance (Thailand) Ltd.
General Motors Acceptance Corporation, Australia
General Motors Acceptance Corporation of Canada, Limited
General Motors Acceptance Corporation, Colombia, S.A.
General Motors Acceptance Corporation, Continental
General Motors Acceptance Corporation del Ecuador S.A. GMAC-Management (Holding)
General Motors Acceptance Corporation Hungary Financial Services Limited Liability Company
General Motors Acceptance Corporation International

Other Subsidiaries, Joint Ventures and Affiliates of General Motors Acceptance Corporation (cont'd):

General Motors Acceptance Corporation Italia S.p.A.
(aka GMAC Italia)
General Motors Acceptance Corporation Nederland N.V.
(aka GMAC Nederland)
General Motors Acceptance Corporation, North America
General Motors Acceptance Corporation (N.Z.) Limited
General Motors Acceptance Corporation del Peru, S.A.
General Motors Acceptance Corporation de Portugal-Servicos Financeiros, S.A.
General Motors Acceptance Corporation, S.A. de C.V.
General Motors Acceptance Corporation, South America
General Motors Acceptance Corporation Suisse S.A.
General Motors Acceptance Corporation (U.K.) Finance plc
(aka GMAC UK plc)
General Motors Acceptance Corporation (U.K.) Public Limited Company
General Motors Acceptance Corporation de Venezuela, C.A.
General Motors Austria Beteligungsgesellschaft m.b.H
(aka GMAC Austria)
Holden National Leasing Limited
HomeComing Financial Network, Inc.
Inversiones 252-29, C.A.
Ladue Associates, Inc.
Lease Auto Receivables, Inc.
Locomotive Leasing Partners, L.L.C.
MIC General Insurance Corporation
MIC Life Insurance Corporation
MIC Life Reinsurance Company, Limited
MIC Property and Casualty Insurance Corporation
MIC Re Corp.
MIC Services Corporation

Other Subsidiaries, Joint Ventures and Affiliates of General Motors Acceptance Corporation (cont'd):

Mortgage Assets Trading, Inc.
Motors Insurance Company Limited
Motors Insurance Corporation
Motors Insurance Purchasing Group, Inc.
Motors Mechanical Reinsurance Company, Limited
NAVCO Corp.
National General Assurance Company
National General Insurance Company
National General Marketing, Inc.
Opel Bank GmbH
Opel Bankgesellschaft m.b.H.
Opel Bank Hungary Reszvenytarsasag
Opel-Handler Versicherungsdienst GmbH
Opel Leasing GmbH & Co. OHG (aka Opel Leasing)
Opel Leasing Verwaltungs GmbH
Opel Leasinggesellschaft m.b.H.
Opel Masterlease GmbH
P. T. GMAC Lippo Finance
Patlan Corporation
Polbank, S.A.
R. L. Autoguard (1992) Limited
RFC Asset Holdings, Inc.
Republic Realty Mortgage Corporation
Residential Accredit Loans, Inc.
Residential Asset Securities Corporation
Residential Consumer Services of Alabama, Inc.
Residential Consumer Services, Inc.
Residential Consumer Services of Ohio, Inc.
Residential Consumer Services of Texas, Inc.
Residential Funding Corporation
Residential Funding Mortgage Exchange Corporation

Other Subsidiaries, Joint Ventures and Affiliates of General Motors Acceptance Corporation (cont'd):

Residential Funding Mortgage Securities I, Inc.
Residential Funding Mortgage Securities II, Inc.
Residential Funding Securities Corporation
Residential Money Centers, Inc.
Risk Monitors, Inc.
Servicios GMAC S.A. de C.V.
Trinity General Agency, Inc.
Vehicle Guarantees Limited
Wholesale Auto Receivables Corporation

Partnerships:

Corral, L.P.
GSL Partners

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No. 96-1312

In the

Supreme Court of the United States

OCTOBER TERM, 1996

ROBERT W. KEARNS,

Petitioner,

v.

GENERAL MOTORS CORPORATION AND BROWN'S BUICK AND ISUZU,

Respondents.

ON PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT.

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

Respondents General Motors Corporation ("GM") and Brown's Buick and Isuzu (hereinafter collectively referred to as "Respondents") hereby oppose the Petition for Writ of Certiorari filed by Robert W. Kearns ("Kearns") in this case.

STATEMENT OF THE CASE

Kearns' brief in support of his Petition constitutes yet another effort by a stubbornly disobedient litigant to blame the entire "Judicial Branch" of government for the consequences of his dilatory and improper conduct as a pro se plaintiff in patent

infringement litigation against GM. Following the dismissal of his action for willful and repeated refusals to obey the discovery orders of the district court in Michigan, Kearns retaliated by filing this second and duplicative action in the federal district court in Virginia, and now seeks to avoid the consequences in the instant case of his conduct in the prior action. He seeks to evade the application by the Virginia district court of the doctrine of *res judicata* against his dismissed prior claims in Michigan, by making the bizarre and unsupportable claim that the Court should extend the life of the patents underlying these lost claims.

Kearns' "Constitutional" arguments here ignore the proper application by the Federal Circuit of the principle of *res judicata*. Kearns' assertion that the Constitution requires this Court to grant him an exception to the laws passed by Congress limiting the enforceable lifetime of patents is unsupported by any authority or precedent, and has been previously advanced by him and rejected by both this Court and the Federal Circuit in earlier litigation by him. Kearns disregards the fact that any "loss" of his patent enforcement rights was caused by his own improper conduct and not by any denial of a Constitutional right. His contentions that the courts below erred in the second dismissal of his claims on grounds of *res judicata*, and in not extending the enforceable life of his patents, represent no more than the stubborn persistence of a *pro se* plaintiff who has unsuccessfully advanced the same baseless arguments before, yet seeks to advance them here once again.

The absence of any sound basis for Kearns' Petition is evident from the full past history of the litigation between Kearns and GM.

Kearns brought suit against GM in the district court of Michigan in 1985, charging infringement of five patents. After eight years of pendency, a time attributable largely to Kearns' own conduct and litigation strategy, Kearns refused to obey the re-

peated orders of the Michigan district court to identify and apply the claims of his patents to any GM products charged by him to infringe. Accordingly, the Michigan district court dismissed the action on July 21, 1993 in accordance with Rules 41(b) and 16(f), Fed. R. Civ. P. The Federal Circuit affirmed and this Court denied certiorari.

Meanwhile, on the day after the Michigan court's dismissal, and prior to his appeal, Kearns brought this second, retaliatory suit against GM before the district court in Virginia, charging infringement *inter alia* of the same five patents dismissed in Michigan, and further charging infringement of sixteen other patents not previously pleaded in Michigan. The Virginia district court thereafter dismissed Kearns' complaint as to all patents in suit on August 29, 1993 on the grounds of *res judicata*: the five patents in suit in Michigan and the sixteen others which could and should have been earlier raised and pleaded therein.

Kearns subsequently appealed. On August 28, 1996, the Federal Circuit affirmed the *res judicata* dismissal of the five patents from the Michigan action, but reversed and remanded as to the sixteen others on the basis that each such patent represents a separate and distinct cause of action not previously adjudicated.

Kearns now petitions here to overcome the Federal Circuit's affirmance of the Virginia district court's dismissal for *res judicata* of the five patents originally in suit in Michigan. He bases his petition on a rambling and extraneously irrelevant contention that his patents, dismissed solely on the grounds of *res judicata*, are somehow entitled to some exemption from dismissal because they expired while his litigation was pending, and that he is "Constitutionally" entitled to a judicially-extended term beyond that limited by statute.

SUMMARY OF THE ARGUMENT

Kearns has failed to identify, either specifically or by reasonable inference, any question which would justify a grant of his Petition and a review of the decisions below. No conflicting appeals court rulings have been identified. No departure from accepted and usual proceedings have been shown to have taken place. No unsettled federal law has been identified.

In his Petition, Kearns' questions presented do not dispute the correctness of the Federal Circuit's decision affirming the trial court's dismissal of his patent infringement action on grounds of *res judicata*. Instead, Kearns makes the improper and irrelevant argument that the enforceable lifetime of his patents should be judicially extended.

Kearns' Petition should be denied by this Court as failing to raise any question which would justify grant of the Petition and review of the lower court decisions.

REASONS FOR DENYING THE PETITION

I. KEARNS HAS FAILED TO IDENTIFY A QUESTION SUBJECT TO REVIEW UNDER SUPREME COURT RULE 10.

None of Kearns' questions presented, nor his Petition in general, meet the standards of Sup. Ct. R. 10. The Federal Circuit affirmed the district court's dismissal of five of Kearns' patent infringement claims on the basis of *res judicata*. In seeking review, Kearns has cited no appeals court decision which conflicts with the Federal Circuit's affirmance, nor has Kearns demonstrated that the Federal Circuit's affirmance "so far departed from the accepted and usual course of judicial proceedings" as to require this Court's supervision. The Federal Circuit reviewed in detail, and specifically identified, the record evidence supporting the district court's holding to ensure that the district court committed no error of law.

In affirming that portion of the district court's decision, the Federal Circuit did not decide any question of federal law which is either unsettled or conflicts with applicable decisions of this Court. The Federal Circuit and the district court acted in full accord with established principles concerning the application of the doctrine of *res judicata*, which bars a claim where a final judgment on the merits has previously been entered in a case involving the same claim. *Nevada* v. *United States*, 463 U.S. 108, 130 (1983). Because a dismisal under Fed. R. Civ. P. 41(b) for failure to prosecute operates as an adjudication on the merits [*e.g. Edwards* v. *City of Houston*, 78 F.3d 983, 994 (5th Cir. 1996; *LeBeau* v. *Taco Bell, Inc.*, 892 F.2d 605, 670 (7th Cir. 1989)], the Virginia district court properly invoked *res judicata* to dismiss Kearns' five claims at issue in the prior Michigan district court action. *Napier* v. *Thirty or More Unidentified Federal Agents*, 855 F.2d 1080, 1087 (3d Cir. 1988); *Kimmel* v. *Texas Commerce Bank*, 817 F.2d 39, 40-41 (7th Cir. 1987).

II. Both This Court and The Court of Appeals for the Federal Curcuit Have Expressly Declared That All Remedies Under a Patent Grant Terminate At the End of the Seventeen Year Period.

The Constitution authorizes Congress to secure *for limited times* to inventors the exclusive right to their discoveries. Art. I, § 8, cl. 8. Congress exercises that authorization through the Patent Statute, which grants the patent owner the right to exclude others from making, using or selling the patented invention in the United States for a limited period. The applicable statutory period for the patents here in suit is seventeen years from the date of issuance. 35 U.S.C. § 154 (1988). These rights become public property upon termination of the patent's statutory term, and any further projection of the patent

monopoly after expiration is not enforceable. *Brulotte, et al.* v. *Thys Co.*, 379 U.S. 29, 30, 32 (1964). In fact, "any attempted reservation or continuation in the patentee or those claiming under him of the patent monopoly, after the patent expires, whatever the legal device employed, runs counter to the policy and purpose of the patent laws." *Scott Paper Co.* v. *Marcalus Co.*, 326 U.S. 249, 256 (1945).

The questions which Kearns seeks to have reviewed by this Court are well settled in law and present no conflict either between appeals courts or with the law as set forth by this Court. Post-expiration injunctive relief is simply unavailable under the Patent Laws. Congress has the power to provide term extension in appropriate circumstances, *see* 35 U.S.C. §§ 155, 156 (1988), and it has chosen not to provide for post-expiration injunctive relief under the circumstances where a patent routinely expires during litigation. *See Denkler* v. *United States*, 782 F.2d 1003, 1008 (Fed. Cir. 1986) ("Should Congress wish to extend the [statute's scope], it knows how to do so.").

In light of the unequivocal state of the law, Kearns' request that the Court judicially establish an exception to the limitations established by Congress on the enforceability of patents would have to be denied even if *res judicata* did not serve to bar these claims as it does. The law is well settled that he can obtain neither injunctive relief under 35 U.S.C. § 283 (1988) after the statutory expiration of his patents, nor monetary damages under 35 U.S.C. §§ 284, 286 (1988) for those patents which expired more than six years before the commencement of his action.

III. The Delay in Adjudicating Kearns' Claims Was the Result of His Own Conduct.

Contrary to the implication of Kearns' argument that an exception to statutory enforceability is required because the delay in the adjudication of his patent claims occurred through no fault of his own, the record is replete with evidence to demonstrate conclusively that Kearns both delayed the filing of this second suit in Virginia until after the dismissal (affirmed by the Federal Circuit) of his first suit in Michigan, engaged in dilatory and improper tactics for which he was solely responsible in the Michigan action and, to the extent his filing of this case was delayed by his pursuit of other litigation against all other members of the world's automobile manufacturing industry, engaged in dilatory and improper litigation tactics that prolonged that other litigation. Thus, any delay that resulted in postponement of the commencement of this action was caused by Kearns. Accordingly, Kearns has no standing to argue that the Court should create an exception to the time limits on the enforceability of his patents.

In the first suit against GM in the district court in Michigan, *Kearns* v. *General Motors Corporation*, Civil No. 85-70461 (E.D. Mich. July 21, 1993), *aff'd*, 31 F.3d 1178 (Fed. Cir. 1994), *cert. denied*, 115 S.Ct. 1105 (1995), Kearns' employment of dilatory and improper tactics for which he was solely responsible caused the action to be pending for eight years. At that point, the court dismissed the action because of Kearns' willful failure to comply with repeated pretrial orders and other defiant conduct on his part.

Similarly, Kearns' cases against other automobile manufacturers were prolonged and delayed by Kearns' own misconduct and dilatory behavior. This behavior was documented by the Federal Circuit in its per curiam opinion in *Kearns* v. *Wood Motors, Inc., et al.*, No. 96-1314 (Fed. Cir. January 17, 1997). As the Federal Circuit's opinion describes, that case began in

1978 and concluded 19 years later when the Federal Circuit upheld the trial court's order requiring Kearns to pay $123,791 in sanctions because of his dishonest and improper conduct. The Federal Circuit noted that Kearns, like all litigants, "must follow the prescribed time limits and procedures, and that once an issue has been finally determined, a litigant cannot relitigate it . . ." (*Id.* at 8), and summarized the history of the case by noting that "Kearns' problems have been largely of his own making." (*Id.* at 10).

This record indisputably demonstrates Kearns' sole responsibility for the expiration of his rights to enforce the patent claims made by him in this action. As such, his extraordinary request to the Court to create an exception to the clear statutory limitations on the enforceability of patents that Congress expressly created is meritless.

IV. Kearns Has Previously Raised the Issue of Extending the Term of His Patents in This Court and in the Federal Court.

The arguments Kearns makes with respect to extending the term of the monopolies granted to him under his patents are arguments that Kearns has made and lost previously before both this Court and the Federal Circuit. In his unsuccessful Petition for a Writ of Certiorari in *Kearns* v. *General Motors Corporation*, Civil No. 85-70461 (E.D. Mich. July 21, 1993), *aff'd*, 31 F.3d 1178 (Fed. Cir. 1994), *cert. denied*, 115 S.Ct. 1105 (1995), and in his appeal below of that case to the Federal Circuit, Kearns made the same bizarre argument in an unsuccessful effort to create a judicial exception to the limited enforceable lifetime of patents clearly prescribed by Congress. Similarly, he unsuccessfully made the same argument to the Federal Circuit in this case. In short, Kearns' argument has been repeatedly rejected, and he should be precluded from making the same failed argument here yet again.

CONCLUSION

Kearns' Petition for Writ of Certiorari fails to identify any questions which would justify grant of the Petition and review of the lower court decisions. Accordingly, Kearns' Petition for Writ of Certiorari should be denied.

Respectfully submitted,

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Attorney for Respondents, General Motors Corporation and Brown's Buick & Isuzu

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APPENDIX A.

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

NOTICE OF ENTRY OF
JUDGMENT ACCOMPANIED BY OPINION

OPINION FILED AND JUDGMENT ENTERED: 02/28/86

The attached opinion announcing the judgment of the court in your case was filed and judgment was entered on the date indicated above. The mandate will be issued in due course.

Information is also provided about petitions for rehearing and suggestions for rehearing in banc. The questions and answers are those frequently asked and answered by the Clerk's Office.

Costs are taxed against the Appellee[s] in favor of the Appellant[s] under Rule 39. The party entitled to costs is provided a bill of costs form and an instruction sheet with this notice.

The parties are encouraged to stipulate to the costs. A bill of costs will be presumed correct in the absence of a timely filed objection.

Costs are payable to the party awarded costs. If costs are awarded to the government, they should be paid to the Treasurer of the United States. Where costs are awarded against the government, payment should be made to the person[s] designated under the governing statutes, the court's orders, and the parties' written settlement agreements. In cases between private parties, payment should be made to counsel for the party awarded costs or, if the party is not represented by counsel, to the party pro se. Payment of costs should not be sent to the court. Costs should be paid promptly.

If the court also imposed monetary sanctions, they are payable to the opposing party unless the court's opinion provides otherwise. Sanctions should be paid in the same was as costs.

Exhibits and visual aids shall be promptly retrieved by the party that lodged them with this court.

/s/_____
FRANCIS X. GINDHART
Clerk

cc: ROBERT W. KEARNS
D. DENNIS ALLEGRETTI

KEARNS V. GENERAL MOTORS, 94-1057
DCT-93-CV-966

APPENDIX B.

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

ORDER

Before NEWMAN, Circuit Judge, PLAGER, Circuit Judge.

A petition for rehearing having been filed by the APPELLANT.

UPON CONSIDERATION THEREOF, it is

ORDERED that the petition for rehearing be, and the same hereby is, DENIED.

The mandate of the court will issue on October 2, 1996.

FOR THE COURT,
FRANCIS X. GINDHARD, CLERK

/s/_____
Brian P. LeDuc
Associate Chief Deputy Clerk

September 26, 1996

cc: ROBERT W. KEARNS
D. DENNIS ALLEGRETTI

KEARNS V. GENERAL MOTORS, 94-1057
(DCT - 93-CV-966)

Note: Pursuant to Fed. Cir. R. 47.6, this order is not citable as precedent. It is a public record.

APPENDIX C.

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

94-1057

ROBERT W. KEARNS,
PLAINTIFF-APPELLANT,

v.

GENERAL MOTORS CORPORATION
AND BROWN'S BUICK & ISUZU,
DEFENDANTS-APPELLEES.

DECIDED: August 28, 1996

Before NEWMAN, Circuit Judge, NIES, Senior Circuit Judge,* and PLAGER, Circuit Judge.
NEWMAN, Circuit Judge.

Robert W. Kearns appeals the dismissal, by the United States District Court for the Eastern District of Virginia, of his suit for patent infringement against the General Motors Corporation and Brown's Buick & Isuzu.[1] The district court held that the action was res judicata based on the involuntary

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* Senior Judge Helen Wilson Nies died on August 7, 1996. The case was decided by the remaining judges in accordance with Fed. Cir. Rule 47.11.

[1] *Kearns* v. *General Motors Corp.*, C.A. No. 93-966-A (E.D. Va. Aug. 29, 1993), *reconsid'n denied*, Sept. 28, 1993, Oct. 26, 1993.

dismissal of an infringement action brought by Dr. Kearns against General Motors in the United States District Court for the Eastern District of Michigan. The Michigan action had been dismissed before trial, for Dr. Kearns' failure to comply with certain deadlines and other orders of the court. There was no adjudication of the merits by the Michigan court; the dismissal was on procedural grounds, and was preceded by the district court's refusal to permit Dr. Kearns, appearing *pro se*, tardily to amend his complaint to add other patents to the five patents that were identified in the complaint.

In the Virginia complaint Dr. Kearns included the five patents that were before the Michigan court plus sixteen additional patents. The Virginia district court held that all twenty-one patents "should have been litigated in the Detroit litigation and they're barred by not having been so." Concerning the devices asserted to be infringing, the Virginia court stated that "even if the controls in the instant case differ from the controls litigated in the Michigan case, the case is still barred by *res judicata*." Neither the Michigan court nor the Virginia court made any substantive determination with respect to any patent or any accused device. The Virginia court did not identify the inventions claimed by any of the patents; the five patents that were also in the Michigan complaint and the sixteen additional patents that were only in the Virginia complaint.

We agree with the Virginia district court that the Michigan decision was *res judicata* in Virginia as to the five patents that were before the Michigan court. That suit could not be reopened in Michirgan, and thus could not be opened in Virginia. However, we conclude that the Michigan decision was not *res judicata* as to the sixteen patents that were presented for the first time in the Virginia complaint.

DISCUSSION

The complaint that was filed in Michigan charged General Motors with infringement of five specified patents. A letter from General Motors to Dr. Kearns dated September 2, 1992, relating to discovery, acknowledged only the five patents in suit. On July 2, 1993 the special master issued an order which stated "Dr. Kearns' letter of June 24, 1993 refers to some 7,424 claim-circuit combinations potentially at issue, involving 23 different patents. There are only five patents in this suit from which to select claims." At a hearing on July 21, 1993 the Michigan court stated that there were only five patents in suit, a statement to which both General Motors and Dr. Kearns agreed.

In its Memorandum accompanying its order of involuntary dismissal, the Michigan court referred to the five patents as the only patents in suit. "Plaintiff alleges ownership of five patents as follows: [five patent numbers listed]." The Memorandum also quotes the special master's order that "There are only five patents in this suit from which to select claims." The district court's order of dismissal did not, either directly or indirectly, include the still-unidentified patents that had not been asserted against General Motors.

The basis of the dismissal in Michigan was Dr. Kearns' inadequate compliance with the court's order and deadlines. Thus the Michigan court rejected Dr. Kearns' attempt to amend his complaint after the court's final deadline. Although Dr. Kearns apparently argued that he needed additional discovery to determine which models infringed which patents, the Michigan court concluded that dismissal under Fed. R. Civ. P. 41(b)[2]

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[2] **Rule 41(b) Involuntary Dismissal: Effect Thereof**

For failure of the plaintiff to prosecute or to comply with these rules or any order of court, a defendant may move for dismissal of an action or of any claim against the defendant. Unless the court in its order for dismissal otherwise specifies,

was appropriate. That decision was affirmed by this court, and is not subject to collateral attack. *Kearns* v. *General Motors Corp.*, 31 F.3d 1178 (Table), 33 USPQ2d 1696 (Fed. Cir. 1994) (nonprecedential), *cert. denied*, 115 S.Ct. 1105 (1995).

A dismissal pursuant to Rule 41(b) is deemed to be on the merits unless the dismissing court specifies otherwise. However, the Michigan decision disposed of only the five patents that were before that court. Each of the sixteen additional patents in the Virginia complaint is, by law, directed to a separate invention. 35 U.S.C. § 101. Indeed, two independent and distinct inventions cannot be claimed in the same patent. *See* 35 U.S.C. § 121:

> If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions.

By statutory and common law, each patent establishes an independent and distinct property right. *See Consolidated Fruit-Jar Co.* v. *Wright*, 94 U.S. 92, 95 (1877) ("A patent for an invention is as much property as a patent for land. The right rests on the same foundation, and is surrounded and protected by the same sanctions."); *Carl Schenck, A.G.* v. *Nortron Corp.*, 713 F.2d 782, 786 n.3, 218 USPQ2d 698 (Fed. Cir. 1983) (a patent is a property right).

Each patent asserted raises an independent and distinct cause of action. Just as infringement of one patent is not a ground of liability for infringement of a different patent, so an involuntary dismissal of a suit regarding one patent is not a ground for dismissal of a different suit on a different patent. A possible

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a dismissal under this subdivision and any dismissal not provided for in this rule, other than a dismissal for lack of jurisdiction, for improper venue, or for failure to join a party under Rule 19, operates as an adjudication upon the merits.

basis for barring the different suit is that the causes of action should have been litigated together. However, precedent illustrates that, in cases in which *res judicata* was applied solely on the basis that a second cause of action could have been included with the first, the first case was fully litigated on its merits nd the same issues were raised in the second case. *E.g.*, *Mars, Inc.* v. *Nippon Conlux Kabushiki-Kaisha*, 58 F.3d 616, 35 USPQ2d 1311 (Fed. Cir. 1995) (claim preclusion barred separate infringement action against Japanese parent corporation after plaintiff had obtained final judgment against its wholly owned American subsidiary); *Pfaff* v. *Wells Electronics, Inc.*, 5 F.3d 514, 28 USPQ2d 1119 (Fed. Cir. 1993) (intrerpretation of a patent claim in prior infringement litigation has issue preclusive effect in second case between same parties; however, disputed facts concerning different accused devices rendered summary judgment improper); *Del Mar Avionics, Inc.* v. *Quinton Instrument Co.*, 836 F.2d 1320, 1324, 5 USPQ2d 1255, 1258 (Fed. Cir. 1987) ("a point not in litigation in one action cannot be received as conclusively settled in any subsequent action upon a different cause, because it might have been determined in the first action") (quoting *Cromwell* v. *County of Sac*, 94 U.S. (4 Otto) 351, 356 (1876)). When applying *res judicata* to bar causes of action that were not before the court in the prior action, due process of law and the interest of justice require cautious restraint. Restraint is particularly warranted when the prior action was dismissed on procedural grounds.

Neither the Michigan nor the Virginia Court discussed the substance of any of the patents before it. However, the Virginia court summarily barred Dr. Kearns from enforcing any of these twenty-one patents. This action rendered unenforceable and useless sixteen patents that had never been before any court. Such a destruction of property rights demands adequate procedural and substantive bases. Rule 41(b) does not reasonably

impose *res judicata* upon causes of action that were not pled in the dismissed action. *See Montana* v. *United States*, 440 U.S. 147, 153 (1979) (*res judicata* requires that there have been "a full and fair opportunity to litigate" the precluded subject matter).

The Michigan court, dismissing Kearns' complaint on procedural grounds, did not, because it could not, reach out to extinguish substantive patent rights that were not before it. In *Lawlor* v. *National Screen Serv. Corp.*, 349 U.S. 3232, 327 (1955) the Court, discussing *res judicata* in connection with a procedural dismissal with prejudice, observed that "the judgment was unaccompanied by findings and hence did not bind the parties on any issue . . . which might arise in connection with another cause of action." *Res judicata* does not automatically apply to claims that might have been included in the prior complaint; it must be shown that they necessarily were included in the judgment, and tht the interest of justice is not disserved by applying *res judicata* to claims that were never presented for adjudication. *See Brown* v. *Felsen*, 442 U.S. 127, 132 (1979) ("Because *res judicata* may govern grounds and defenses not previously litigated, however, it blockades unexplored paths that may lead to truth. For the sake of repose, *res judicata* shields the fraud and the cheat as well as the honest person. It is therefore invoked only after careful inquiry.").

Issue preclusion, of narrower scope than *res judicata*, requires that the identical issue was decided on the merits between the same parties. 1B James W. Moore et al., *Moore's Federal Practice*, ¶¶ 0.401, 0.405, 0.441 (2d ed. 1992). In the case at bar, it is not possible to show that the identical issue was presented in the sixteen patents that were not before the Michigan court, as in the five patents that were; for each patent, by law, covers an independent and distinct invention. Further, infringement must be separately proved as to each patent. *See*

generally, Young Engineers, Inc. v. *United States Int'l Trade Comm'n*, 721 F.2d 1305, 1316, 219 USPQ 1142, 1152 (Fed. Cir. 1983), wherein this court stated, albeit in dictum, that "With respect to patent litigation, we are unpersuaded that an 'infringement claim,' for purposes of claim preclusion, embraces more than the specific devices before the court in the first suit." *See also, e.g., Angel* v. *Bullington*, 330 U.S. 183, 202-03 (1947) ("It is not every case in which a litigant has had 'one bit at the cherry' that the law forbids another. In other words, it is not every such case in which the policy of stopping litigation out weighs that of showing the truth.") *See generally* 18 C. Wright, A. Miller and E. Cooper, *Federal Practice and Procedure*, §§ 4419, 4442, 4443 (1981) (discussing the appropriateness of a flexible view); *Restatement (Second) of Judgments* § 27 comment e (1982) ("In the case of a judgment entered by confession, consent, or default, none of the issues is actually litigated" and issue preclusion does not apply).

We conclude that the dismissal of the Michigan suit under Rule 41(b) did not impose the bar of *res judicata* upon patents that had not been included in the Michigan suit, were not before the Michigan court, and were not part of the Michigan judgment. Precedent cautions that *res judicata* is not readily extended to claims that were not before the court, and precedent weighs heavily against denying litigants a day in court unless there is a clear and persuasive basis for that denial.

We conclude that the Michigan dismissal was *res judicata* only with respect to the five patents that were before the Michigan court. The dismissal is affirmed as to these five patents. The dismissal is vacated as to the sixteen patents that were not before the Michigan court. The case is remanded for appropriate further proceedings.

Costs to Dr. Kearns.

AFFIRMED IN PART, VACATED IN PART, and REMANDED

APPENDIX D.

IN THE UNITED STATES DISTRICT COURT FOR THE
EASTERN DISTRICT OF VIRGINIA
Alexandria Division

ROBERT W. KEARNS,
Plaintiff,

v. Civil Action No. 93-966-A

GENERAL MOTORS CORP., ET AL.,
Defendants.

ORDER

This matter comes before the Court on defendant's motion to dismiss.

For the reasons stated from the bench, the motion is hereby GRANTED.

The Clerk is directed to send copies of this Order to all counsel of record.

/s/_____
T. S. Ellis, III
United States District Judge

Alexandria, Virginia
August 27, 1993

APPENDIX E.

IN THE UNITED STATES DISTRICT COURT FOR THE EASTERN DISTRICT OF VIRGINIA
Alexandria Division

ROBERT W. KEARNS,
Plaintiff,

v. Civil Action No. 93-966-A

GENERAL MOTORS CORP., AND
BROWN'S BUICK & ISUZU,
Defendants.

ORDER

This matter comes before the Court on plaintiff's motion for reconsideration.

The Court holds that:

1. The disputed controls in the instant case do not appear to be substantially different from the controls litigated in the previous Michigan case.

2. Even if the controls in the instant case differ from the controls litigated in the Michigan case, the case is still barred by *res judicata*. *See Sanders Confectionery Products* v. *Heller Financial*, 973 F.2d 474 (6th Cir. 1992).

3. The fact that the Michigan suit was dismissed without a trial does not prevent a finding of *res judicata*. *See Young Engineers* v. *U.S. Int'l Trade Comm'n*, 721 F.2d 1305, 1314 (Fed. Cir. 1983).

For these reasons, plaintiff's motion for reconsideration is DENIED.

The Clerk is directed to send copies of this Order to all counsel of record.

/s/_____
T. S. Ellis, III
United States District Judge

Alexandria, Virginia
September 28, 1993

APPENDIX F.

IN THE UNITED STATES DISTRICT COURT FOR THE
EASTERN DISTRICT OF VIRGINIA
Alexandria Division

ROBERT W. KEARNS,
Plaintiff,

v. Civil Action No. 93-966-A

GENERAL MOTORS CORPORATION AND
BROWN'S BUICK & ISUZU,
Defendants.

ORDER

This matter comes before the Court on plaintiff's motion for reconsideration of this Court's denial of plaintiff's prior motion for reconsideration and on plaintiff's motion to file additional documents under seal.

In an order dated September 26, 1993, this Court denied plaintiff's motion for reconsideration. Plaintiff's motion for reconsideration of this order is DENIED.

The Court ORDERS the additional documents submitted by plaintiff to be filed by the Clerk of this Court.

The Clerk is directed to send copies of this Order to all counsel of record.

/s/_____
T. S. Ellis, III
United States District Judge

Alexandria, Virginia
October 26, 1993